

Sonos, Inc.’s Motion *In Limine* No. 3

EXHIBIT A

1 QUINN EMANUEL URQUHART & SULLIVAN, LLP

Charles K. Verhoeven (Bar No. 170151)

2 charlesverhoeven@quinnemanuel.com

Melissa Baily (Bar No. 237649)

3 melissabaily@quinnemanuel.com

Lindsay Cooper (Bar No. 287125)

4 lindsaycooper@quinnemanuel.com

50 California Street, 22nd Floor

5 San Francisco, California 94111-4788

Telephone: (415) 875-6600

6 Facsimile: (415) 875-6700

7 Attorneys for GOOGLE LLC

8 **UNITED STATES DISTRICT COURT**

9 **NORTHERN DISTRICT OF CALIFORNIA**

10 **SAN FRANCISCO DIVISION**

11 GOOGLE LLC,

12 Plaintiff

13 v.

14 SONOS, INC.,

15 Defendant.

CASE NO. 3:20-cv-06754-WHA

**GOOGLE LLC'S INVALIDITY
CONTENTIONS**

1 of Lambourne, Millington, Rajapakse, Sonance DAB1, Sonos Forums, Sonos System, Bose
2 System, Crestron Adagio, Home Director and Squeezebox in combination with:

3 1) For claims 1 and 9, the prior art of Riders A, C-E, G-H and L.

4 2) For claims 4 and 12, the prior art of Rider B

5 3) For claims 8 and 16, the prior art of Rider F

6 In addition to the prior art references discussed above, which may be combined, Google
7 discloses Exhibits Rider A-H and L, which each disclose certain areas of prior art known in the
8 field and which may be combined with the disclosed references to render obvious the Asserted
9 Claims.

- 10 1. Rider A – speaker grouping (applies to claims 1, 9)
- 11 2. Rider B – storing group information at a speaker (applies to claims 4, 12)
- 12 3. Rider C – remote control of speaker groups (applies to claims 1, 9)
- 13 4. Rider D – dynamic modification of speaker groups (applies to claims 1, 9)
- 14 5. Rider E – creating or using “scene” information (applies to claims 1, 9)
- 15 6. Rider F – graphical user interface (applies to claims 8, 16)
- 16 7. Rider G – naming a group (applies to claims 1, 9)
- 17 8. Rider H – overlapping or non-overlapping groups (applies to claims 1, 9)
- 18 9. Rider L – digital data network (applies to claims 1, 9)

19 Google provides further disclosure regarding obviousness in Section IX, below.

20 **C. Invalidity Under 35 U.S.C. § 112**

21 Google identifies below grounds of invalidity under 35 U.S.C. § 112. The grounds
22 identified below both individually and collectively render the '966 Asserted Claims invalid under
23 the statutory requirements of § 112. By identifying certain claim language below, Google does
24 not imply that such language is entitled to any patentable weight when comparing the claim as a
25 whole to the prior art. Google's identifications are made based on Google's present understanding
26 of the Asserted Claims and Sonos's apparent interpretation of these claims as reflected in its
27 Infringement Contentions, and Google reserves the right to amend these identifications, including
28

1 in response to claim constructions and claim interpretations that would render claim limitations
2 not enabled, lacking in written description, or indefinite.

3
4 **1. Lack of Enablement And Written Description Under 35 U.S.C. § 112**
5 **¶ 1**

6 Based on Google's present understanding of the Asserted Claims and Sonos's apparent
7 interpretation of these claims as reflected in its Infringement Contentions, the '966 Asserted
8 Claims may fail to satisfy the requirements of § 112, ¶ 1 because the specification and original
9 patent application fail to provide an enabling disclosure of and written description support for at
least the following limitations and terms within the cited phrases (or terms contained therein):

- 10 • "zone player"
- 11 • "zone scene"
- 12 • "networked media playback system"
- 13 • "configured to play back media individually" / "operating in a standalone mode"
- 14 • "second predefined grouping of zone players including at least the first zone player
15 and a third zone player that are to be configured for synchronous playback of media
when the second zone scene is invoked"
- 16 • "based on the second request, i) causing creation of the second zone scene, ii)
17 causing an indication of the second zone scene to be transmitted to the first zone
player, and iii) causing storage of the second zone scene" / "based on the second
18 request, i) causing creation of the second zone scene, ii) causing an indication of
the second zone scene to be transmitted to the first zone player, and iii) causing
19 storage of the second zone scene"
- 20 • "based on the third request, causing the first zone player to transition from
operating in the standalone mode to operating in accordance with the first
21 predefined grouping of zone players such that the first zone player is configured to
coordinate with at least the second zone player to output media in synchrony with
22 output of media by at least the second zone player" / "based on the third request,
causing the first zone player to transition from operating in the standalone mode to
23 operating in accordance with the first predefined grouping of zone players such that
the first zone player is configured to coordinate with at least the second zone player
24 to output media in synchrony with output of media by at least the second zone
player."
- 25 • "predefined grouping of zone players"
- 26 • "invoked" / "invoke"
- 27 • "transition from operating in the standalone mode to operating in accordance with
28 the first predefined grouping of zone players"

- “first zone player is configured to coordinate with at least the second zone player to output media in synchrony with output of media by at least the second zone player”
- “cease to operate in accordance with the first predefined grouping of zone players”
- “begin to operate in accordance with the second predefined grouping of zone players”
- “first zone player is configured to coordinate with at least the third zone player to output media in synchrony with output of media by at least the third zone player”

2. Indefiniteness Under 35 U.S.C. § 112 ¶ 2

Based on Google’s present understanding of the Asserted Claims and Sonos’s apparent interpretation of these claims as reflected in its Infringement Contentions, the ’966 Asserted Claims may fail to satisfy the requirements of § 112, ¶ 2 because the precise scope of at least the phrases listed below (or terms contained therein) cannot be determined with reasonable certainty by a POSITA when reading the claims in light of the specification and prosecution history.

- “zone player”
- “zone scene”
- “networked media playback system”
- “configured to play back media individually” / “operating in a standalone mode”
- “second predefined grouping of zone players including at least the first zone player and a third zone player that are to be configured for synchronous playback of media when the second zone scene is invoked”
- “based on the second request, i) causing creation of the second zone scene, ii) causing an indication of the second zone scene to be transmitted to the first zone player, and iii) causing storage of the second zone scene” / “based on the second request, i) causing creation of the second zone scene, ii) causing an indication of the second zone scene to be transmitted to the first zone player, and iii) causing storage of the second zone scene”
- “based on the third request, causing the first zone player to transition from operating in the standalone mode to operating in accordance with the first predefined grouping of zone players such that the first zone player is configured to coordinate with at least the second zone player to output media in synchrony with output of media by at least the second zone player” / “based on the third request, causing the first zone player to transition from operating in the standalone mode to operating in accordance with the first predefined grouping of zone players such that the first zone player is configured to coordinate with at least the second zone player to output media in synchrony with output of media by at least the second zone player.”
- “predefined grouping of zone players”

- 1 • “invoked” / “invoke”
- 2 • “transition from operating in the standalone mode to operating in accordance with
- 3 the first predefined grouping of zone players”
- 4 • “first zone player is configured to coordinate with at least the second zone player to
- 5 output media in synchrony with output of media by at least the second zone player”
- 6 • “cease to operate in accordance with the first predefined grouping of zone players”
- 7 • “begin to operate in accordance with the second predefined grouping of zone
- 8 players”
- 9 • “first zone player is configured to coordinate with at least the third zone player to
- 10 output media in synchrony with output of media by at least the third zone player”

3. Functional Claiming

11 § 112 ¶ 6 limits functional claiming. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339,
 12 1349–51 (Fed. Cir. 2015) (en banc) (imposing new standard of indefiniteness to address
 13 “proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth
 14 in the statute”); *Function Media, LLC v. Google, Inc.*, 708 F.3d 1310, 1319 (Fed. Cir. 2013). It
 15 allows the patentee to claim the invention by the functions it performs, but limits the scope of
 16 those claims to the specific solutions disclosed in the specification—because in this country, the
 17 patentee cannot claim more than what she invented. *MySpace, Inc. v. GraphOn Corp.*, 672 F.3d
 18 1250, 1256 (Fed. Cir. 2012). The following claim limitations are functional and thus are subject
 19 to § 112 ¶ 6 requirements and are indefinite for lack of structures in the specification, and are also
 20 not enabled because of the lack of structures:

- 21 • “cause....”
- 22 • “causing....”
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1 contentions. In addition, as further explained in Exhibit 885-1 through Exhibit 885-10, the
2 following claims are obvious under one or more interpretations in view of one of Lambourne,
3 Millington, Rajapakse, Sonance DAB1, Sonos Forums, Sonos System, Bose System, Crestron
4 Adagio, Home Director and Squeezebox in combination with:

5 1) For claims 1 and 8, the prior art of Riders A-E, G-H and L

6 In addition to the prior art references discussed above, which may be combined, Google
7 discloses Exhibits Rider A – Rider H and Rider L, which each disclose certain areas of prior art
8 known in the field and which may be combined with the disclosed references to render obvious the
9 Asserted Claims.

- 10 1. Rider A – speaker grouping
- 11 2. Rider B – storing group information at a speaker
- 12 3. Rider C – remote control of speaker groups
- 13 4. Rider D – dynamic modification of speaker groups
- 14 5. Rider E – creating or using “scene” information
- 15 6. Rider G – naming a group
- 16 7. Rider H – overlapping or non-overlapping groups
- 17 8. Rider L – digital data network

18 Google provides further disclosure regarding obviousness in Section IX, below.

19 **C. Invalidity Under 35 U.S.C. § 112**

20 Google identifies below grounds of invalidity under 35 U.S.C. § 112. The grounds
21 identified below both individually and collectively render the '885 Asserted Claims invalid under
22 the statutory requirements of § 112. By identifying certain claim language below, Google does
23 not imply that such language is entitled to any patentable weight when comparing the claim as a
24 whole to the prior art. Google’s identifications are made based on Google’s present understanding
25 of the Asserted Claims and Sonos’s apparent interpretation of these claims as reflected in its
26 Infringement Contentions, and Google reserves the right to amend these identifications, including
27 in response to claim constructions and claim interpretations that would render claim limitations
28 not enabled, lacking in written description, or indefinite.

1
2 **1. Lack of Enablement And Written Description Under 35 U.S.C. § 112**
3 **¶ 1**

4 Based on Google's present understanding of the Asserted Claims and Sonos's apparent
5 interpretation of these claims as reflected in its Infringement Contentions, the '885 Asserted
6 Claims may fail to satisfy the requirements of § 112, ¶ 1 because the specification and original
7 patent application fail to provide an enabling disclosure of and written description support for at
8 least the following limitations below (or terms contained therein):

- 9 • "zone player"
- 10 • "zone scene"
- 11 • "operating in a standalone mode"
- 12 • "predefined grouping of zone players"
- 13 • "invoked"
- 14 • "causing storage"
- 15 • "displaying a representation of the first zone scene and a representation of the
16 second zone scene"
- 17 • "transition from operating in the standalone mode to operating in accordance with
18 the given one of the first and second predefined groupings of zone players"
- 19 • "first zone player is configured to coordinate with at least one other zone player in
20 the given one of the first and second predefined groupings of zone players over a
21 data network in order to output media in synchrony with output of media by the at
22 least one other zone player in the given one of the first and second predefined
23 groupings of zone players"
- 24 • "ceasing to operate in accordance with the first predefined grouping of zone
25 players"
- 26 • "beginning to operate in accordance with the second predefined grouping of zone
27 players"

28 Google further discloses that the original disclosure does not include the concept of
synchronization among zone players after playback begins. That disclosure does not provide or
create a motivation for transitioning or coordination of zone players. Similarly, the original
disclosure does not provide that zone players may belong to more than one group or scene at the
same time.

1 **2. Indefiniteness Under 35 U.S.C. § 112 ¶ 2**

2 Based on Google’s present understanding of the Asserted Claims and Sonos’s apparent
3 interpretation of these claims as reflected in its Infringement Contentions, the ’966 Asserted
4 Claims may fail to satisfy the requirements of § 112, ¶ 2 because the precise scope of at least the
5 phrases listed below (or terms contained therein) cannot be determined with reasonable certainty
6 by a POSITA when reading the claims in light of the specification and prosecution history.

- 7 • “zone player”
8 • “zone scene”
9 • “operating in a standalone mode”
10 • “predefined grouping of zone players”
11 • “invoked”
12 • “causing storage”
13 • “displaying a representation of the first zone scene and a representation of the
14 second zone scene”
15 • “transition from operating in the standalone mode to operating in accordance with
16 the given one of the first and second predefined groupings of zone players”
17 • “first zone player is configured to coordinate with at least one other zone player in
18 the given one of the first and second predefined groupings of zone players over a
19 data network in order to output media in synchrony with output of media by the at
20 least one other zone player in the given one of the first and second predefined
21 groupings of zone players”
22 • “ceasing to operate in accordance with the first predefined grouping of zone
23 players”
24 • “beginning to operate in accordance with the second predefined grouping of zone
25 players”

26 **3. Functional Claiming**

27 § 112 ¶ 6 limits functional claiming. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339,
28 1349–51 (Fed. Cir. 2015) (en banc) (imposing new standard of indefiniteness to address
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1 patentee cannot claim more than what she invented. *MySpace, Inc. v. GraphOn Corp.*, 672 F.3d
2 1250, 1256 (Fed. Cir. 2012). The following claim limitations are functional and thus are subject
3 to § 112 ¶ 6 requirements and are indefinite for lack of structures in the specification, and are also
4 not enabled because of the lack of structures:

- 5 • “cause...”

6 **VI. '206 PATENT**

7 **A. Patent Local Rule 3-3(A) – Identification of Prior Art ⁷**

8 **1. Prior Art Patents And Publications**

9 The following patents and publications are prior art to the '206 Asserted Claims under at
10 least 35 U.S.C. §§ 102(a), (b), (e), and/or (g). Google incorporates by reference all prior art
11 references cited on the face of the '206 patent, related patents, and all foreign counterparts.
12 Google further incorporates by reference any prior art references identified in the file history of
13 the same. Google reserves the right to rely upon foreign counterparts of the U.S. Patents identified
14 in these invalidity contentions, U.S. counterparts of foreign patents and foreign patent applications
15 identified in these invalidity contentions, U.S. and foreign patents and patent applications
16 corresponding to articles and publications identified in these invalidity contentions, and any
17 systems, products, or prior inventions related to any references identified in these invalidity
18 contentions.

19 *See* prior art publications identified in Section IV.A.

20 Google additionally identifies and relies on patent or publication references that describe or
21 are otherwise related to the prior art systems identified below. Google's investigation into prior
22 art patent and publication references remains ongoing, and Google reserves the right to identify
23 and rely on additional patent or publication references that are identified through further
24 investigation or discovery. Google reserves the right to supplement as further prior art is
25 identified through investigation or discovery.

26
27 ⁷ Google also hereby identifies any systems or products that embody the technology described in
28 any patent or publication identified in these Invalidity Contentions. Google reserves the right to
rely on any documents or other evidence regarding any such systems

1 additional prior art. These third parties include, without limitation, the authors, inventors,
2 vendors, or assignees of the references listed in these disclosures.

3 Google further reserve the right to modify or add additional contentions in the event that
4 Sonos provides amended infringement contentions and to the extent the Court orders or allows
5 Sonos to amend its infringement contentions.

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7 Dated: December 6, 2021

QUINN EMANUEL URQUHART &
SULLIVAN, LLP

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9 By: /s/ Charles K. Verhoeven
Charles K. Verhoeven (pro hac vice)
charlesverhoeven@quinnemanuel.com
Melissa Baily (pro hac vice)
melissabaily@quinnemanuel.com
Lindsay Cooper (pro hac vice)
lindsaycooper@quinnemanuel.com
QUINN EMANUEL URQUHART &
SULLIVAN LLP
50 California Street, 22nd Floor
San Francisco, California 94111-4788
Telephone: (415) 875 6600
Facsimile: (415) 875 6700

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17 *Counsel for Defendant Google LLC*
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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the above and foregoing document was served on counsel for plaintiff Sonos, Inc. via electronic delivery on December 6, 2021.

/s/ Nima Hefazi
Nima Hefazi